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JUN 18 2008

OFFICE OF PETITIONS

In re Application of : DECISION DISMISSING PETITIONS
La Rosa et al. : UNDER 37 CFR 1.78(a)(3) and (a)(6)
Application No. 10/612783 : AND
Filed: 07/02/2003 : DECISION ON REQUEST
Attorney Docket No. 38-21(53373)A : UNDER 37 CFR 1.48(a)

This is a decision on the "PETITION TO AMENDMENT PRIORITY UNDER 37 C.F.R. § 1.78(a)(3)," filed on April 24, 2008, which is treated as a petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed nonprovisional and provisional applications set forth in the concurrently filed amendment. This is also a decision on the request to correct inventorship under 37 CFR § 1.48(a), concurrently filed on April 24, 2008.

The petitions are **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

Petitioner has submitted an amendment and an Application Data Sheet containing claims of benefit under 37 CFR 1.78(a)(3) and (a)(6) to the prior-filed nonprovisional and provisional applications.

At the outset, a review of Office computer database records indicates that there is a lack of common inventorship between the instant nonprovisional application and some of the nonprovisional and provisional applications noted in the amendment and ADS submitted concurrently with the instant petition. The statute requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. §119(e) or 120 be filed by an inventor or inventors named in the prior-filed nonprovisional or provisional application.

While petitioners have submitted a request to correct the inventorship under 37 CFR 1.48(a) to add the inventors of the prior-filed applications, the request under 37 CFR 1.48(a) is not grantable for the reasons stated below. Accordingly, a decision on the petition under 37 CFR 1.78(a)(3) and (a)(6) will be held in abeyance pending submission of a grantable request under 37 CFR 1.48(a).

Furthermore, where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP 201.06(d).

Petitioners should review the claim for priority to ensure that a reference is made to the first application and to every intermediate application. In this regard, a review of Office records reveals that prior-filed Application No. 09/816,660, filed on March 26, 2001, and now abandoned, does not contain a claim for the benefit of prior-filed Application No. 09/733,089. Accordingly, a petition under 37 CFR 1.78(a)(3) would be required to be filed in Application No. 09/816,660 to add the benefit claim to prior-filed Application No. 09/733,089.

For those applications filed prior to November 29, 2000, no petition under 37 CFR 1.78 is required to be filed to add the benefit claim. However, the benefit claim must be corrected by way of an amendment and, if the application in which the benefit claim is filed is currently abandoned, a petition under 37 CFR 1.182 requesting entry of the amendment, accompanied by the required petition fee. In this regard, 35 U.S.C. § 120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to November 29, 2000 to include the benefit of an earlier filing date for purposes other than prosecution. See Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (DC DC 1976).

Further in this regard, Application No. 09/333,535, filed on June 14, 1999, and now abandoned, does not contain a claim for the benefit of prior-filed Application No. 60/089,524, and

Application No. 09/615,606, filed on July 13, 2000, and now abandoned, does not contain a claim for the benefit of prior-filed Application No. 60/144,084. Likewise, Application No. 09/565,306, filed on May 4, 2000, and now abandoned, does not contain a claim for the benefit of prior-filed Application No. 60/132,860. Application No. 09/552,086, filed on April 19, 2000, and now abandoned, does not contain a claim for the benefit of prior-filed Application Nos. 60/130,464, 60/141,132, 60/141,139, 60/141,135, or 60/130,174. Application No. 09/531,113, filed on March 22, 2000, and currently pending, does not contain a claim for the benefit of prior filed Application Nos. 60/125,818, 60/125,817, 60/141,132, 60/141,139, 60/141,135, or 60/130,174. Lastly, Application No. 09/663,423, filed on September 15, 2000, and now abandoned, does not contain a claim for the benefit of prior-filed Application No. 60/154,375.

Upon the granting of a petition under 37 CFR 1.78 in Application No. 09/816,660, filed on March 26, 2001, to add the claim of benefit to the prior-filed application, and the filing of an amendment in each of the above-identified applications filed prior to November 29, 2000 for which a claim of benefit is required addressing the above matters, accompanied by a petition under 37 CFR 1.182 and the required fee if the application in which the benefit claim is being made is currently abandoned, petitioners may file a renewed petition in the subject application. A copy of the grant of the petition under 37 CFR 1.78 in prior-filed application No. 09/816,660, and a copy of the amendments, and grant of the petition under 37 CFR 1.182, if required, in those applications filed prior to November 29, 2000, should accompany the renewed petition.

Lastly, the amendment with the subject petition to add the claims of benefit is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

REQUEST UNDER 37 CFR 1.48(a)

37 CFR 1.48(a) states that if the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors.

Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;

- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

The request lacks items (2), (3), and (5).

With regard to item (2), no statement the error in inventorship occurred without deceptive intention on his or her part has been filed for proposed inventor Thomas G. Ruff.

With regard to item (3), the oath or declaration contains unsigned/undated alterations for proposed inventors Mark S. Abad, Dane K. Fisher, and Donald E. Nelson. 37 CFR 1.52(c) requires any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Further review of the declaration reveals that there also appear to be alterations for proposed inventor Raghunath V. Lalgudi in that the mailing address appears to contain a strikeout with no correction; and for proposed inventor Michael D. Thompson in that the residence city and state appears to contain a strikeout with no correction.

A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, listing the residence, mailing address, and citizenship of all of the inventors and signed by the inventor to whom the corrections pertain (*i.e.*, proposed joint inventors Abad, Fisher, Lalgudi, Nelson, and Thompson) must be provided with any renewed petition.

With regard to item (4), it is unclear from the papers filed with the petition whether an assignment has been executed by any of the original named inventors. Petitioners should state whether or not any of the original named inventors have executed an assignment. If an assignment has been so executed, written consent of the assignee must be provided with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231



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